



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/098,504 | 03/18/2002 | Norihisa Takayama | 018656-268 | 4424 |

7590 06/29/2006

Platon N. Mandros
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. BOX 1404
Alexandria, VA 22313-1404

EXAMINER

BURLESON, MICHAEL L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2625

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/098,504 | TAKAYAMA, NORIHISA | |
| | Examiner | Art Unit | |
| | Michael Burleson | 2626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments, see 7-11, filed 3/30/2006, with respect to the rejection(s) of claim(s) 1-18 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Saito et al. US 6208426 and Toyoda US 6441916.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,3-9,11-14 and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Saito et al. US 6208426.

3. Regarding claim 1, Saito et al. teaches of a data transmission apparatus (netfax (1)); an e-mail transmission unit for sending e-mail (e-mail generator (24)); a data forwarding unit for forwarding data to a prescribed storage area (html document generator (22)) and a controller for controlling the e-mail transmission unit such that a

Art Unit: 2626

tool program by which to obtain the data stored in the prescribed storage area is sent to a recipient using e-mail (server mechanism (25)) (column 5,lines 3-25 and 57-61).

4. Regarding claim 3, Saito et al. teaches that the prescribed storage area comprises a storage unit residing inside the data transmission apparatus (figure 2).

5. Regarding claim 4, Saito et al. teaches that the prescribed storage area comprises an external device other than the data transmission apparatus or a storage unit inside the external device (server mechanism) (column 4,lines 25-30).

6. Regarding claim 5, Saito et al. teaches the tool program includes access information based on which the recipient can access the data stored in the prescribed storage area (column 5,lines 57-61).

7. Regarding claim 6, Saito et al. teaches the access information is incorporated in the tool program in a form such that the confidentiality of the access information is maintained (column 5,lines 57-61).

8. Regarding claim 7, Saito et al. teaches the data to be handled includes image data (column 4,lines 25-30).

9. Regarding claim 8, Saito et al. teaches of an image reader for reading an image of an original document to obtain image data thereof, (scanner section (16)) and wherein the data to be handled includes the image data obtained by the image reader (column 4,lines 25-30, lines 59-62).

10. Regarding claim 9, Saito et al. teaches a method for delivering data for use with a data transmission apparatus, comprising (a) storing data in a prescribed storage area

and (b) sending to a recipient via e-mail a tool program by which to obtain the data stored in the prescribed storage area (column 5, lines 3-25 and 57-61).

11. Regarding claim 11, Saito et al. teaches the tool program includes access information based on which the recipient can access the data stored in the prescribed storage area (column 5, lines 57-61).

12. Regarding claim 12, Saito et al. teaches the access information is incorporated in the tool program in a form such that the confidentiality of the access information is maintained (column 5, lines 57-61).

13. Regarding claim 13, Saito et al. teaches the data to be handled includes image data (column 4, lines 25-30).

14. Regarding claim 14, Saito et al. teaches a computer readable medium storing program executable by a computer to make a computer perform a routine, comprising the steps of: (a) storing data in a prescribed storage area and (b) sending to a recipient via e-mail a tool program by which to obtain the data stored in the prescribed storage area (column 4, lines 47-56 and column 5, lines 3-25 and 57-61).

15. Regarding claim 16, Saito et al. teaches the tool program includes access information based on which the recipient can access the data stored in the prescribed storage area (column 5, lines 57-61).

16. Regarding claim 17, Saito et al. teaches the access information is incorporated in the tool program in a form such that the confidentiality of the access information is maintained (column 5, lines 57-61).

Art Unit: 2626

17. Regarding claim 18, Saito et al. teaches the data to be handled includes image data (column 4, lines 25-30).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 2, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. US 6208426 in view of Toyoda US 6441916.

20. Regarding claim 2, Saito et al. teaches all of the limitations of claim 1 and wherein the controller controls the e-mail transmission unit such that the e-mail transmission unit sends to the recipient a first e-mail to which the data is attached (column 5, lines 3-25 and 57-61), and the controller controls the e-mail transmission unit such that the tool program is sent to the recipient using a second e-mail (column 5, lines 21-25).

21. Saito et al. fails to teach of recognition unit for recognizing e-mail transmission errors, and where a transmission error is recognized by the recognition unit in connection with the first e-mail.

22. Toyoda teaches of recognition unit for recognizing e-mail transmission errors (header/IFD analysis section (5)), and where a transmission error is recognized by the recognition unit in connection with the first e-mail (column 5, lines 3-18).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have modified Saito et al. wherein Saito et al.'s apparatus is applied to recognition of file size limits of e-mail transmissions. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Saito et al. by the teaching of Toyoda in order to view e-mail attachments that exceed file size limits.

23. Regarding claim 10, the structural elements of apparatus claim 2 perform all of the steps of method claim 10. Thus, claim 10 is rejected for the same reasons discussed in the rejection of claim 2.

24. Regarding claim 15, the structural elements of apparatus claim 2 perform all of the steps of computer readable medium claim 15. Thus, claim 15 is rejected for the same reasons discussed in the rejection of claim 2.

Conclusion

Any inquiry concerning this communication should be directed to Michael Burleson whose telephone number is (571) 272-7460 and fax number is (571) 273-7460. The examiner can normally be reached Monday thru Friday from 8:00 a.m. – 4:30p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at (571) 272-7471

Application/Control Number: 10/098,504
Art Unit: 2626

Page 7

Michael Burleson
Patent Examiner
Art Unit 2626

MB

Mlb
June 23, 2006

KA Williams
KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER